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20350      7590      01/16/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
			EXAMINER CHEUNG, MARY DA ZHI WANG	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/872,764  
Filing Date: June 01, 2001  
Appellant(s): GRAINGER ET AL.

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Chad E. King  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 6, 2008 appealing from the Office action mailed August 16, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

- U.S. Patent Application No. 09/919,764; appeal filed.
- U.S. Patent Application No. 09/919,768; appeal filed
- U.S. Patent Application No. 09/996,338 (Appeal No. 2007-0776); the examiner's rejections were affirmed, and case is abandoned.
- U.S. Patent Application No. 09/996,341; the examiner's rejections were affirmed, and case is abandoned.
- U.S. Patent Application No. 09/997,311; abandoned

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection filed on September 27, 2007 has been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

- 5,982,898                      HSU et al.                      11-1999
- 6,182,078 B1                WHITMYER, JR.                01-2001
- ePave User Guide published by U. S. Patent and Trademark Office, January 12, 2000.
- U. S. Patent Application Specification Authoring Guide for WordPerfect XML Template, December 14, 1999.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims. The action is copied from the final office action mailed on August 16, 2007 except for the claim 16 objection due to the after amendment of claim 1.

***Claim Objections***

1. Claim 16 is objected to because of the following informalities: the word "smart" should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-3 and 38-39 are rejected under 35 U.S.C. 102(a) as being anticipated by ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000.

As to claim 1, ePave discloses a computer-implement method for securing intellectual property rights, the method comprising (page 1):

- a) Providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out is taught by ePave as allowing a smart electronic invention disclosure form to be downloaded from USPTO's computer to a client computer, and the electronic invention disclosure form can be filled out (pages 1, 9, 12, 17-21);
- b) Actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form (pages 19-21);
- c) Receiving a filled-out invention disclosure in electronic form on the first server is taught by ePave as submitting a filled-out invention disclosure in electronic form to USPTO's computer, and USPTO's computer will send acknowledgment receipt to the client computer upon receiving the form (pages 29-31, 49).
- d) Automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client computer and received by the server (pages 18-19, 28-29).

As to claim 2, ePave discloses active prompting an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention (pages 17-21, 51-52).

As to claim 3, ePave discloses active prompting an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention (pages 17-21, 51-52).

Claims 38-39 are parallel with claim 1; thus they are rejected for the similar reason as claim 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000.

As to claim 4, ePave discloses the smart disclosure form prompts an inventor to input information in pre-selected fields (pages 18-19). EPave does not specifically state that prompting an inventor by the disclosure form to identify co-inventors if there are any. It would have been obvious to one of ordinary skill in the art to include the feature of identifying co-inventions if there are any in the system of ePave because it is well known in the art that lots of applications have multiple inventors, and all the names of

the inventors along with their signatures are required to be included in the applications. Thus, in order to compliance with patent law/rule and to further avoid any legal issues about inventorship, one of ordinary skill in the art would have been motivated to include the feature of identifying co-inventors in the system of ePave.

As to claim 5, ePave discloses wherein information in pre-selected files of the invention disclosure form is selectively placed in a pre-selected location in said patent application (pages 18-19, 28-29).

As to claim 6, ePave discloses the single click also causes the patent application to be filed at a patent office (pages 28-29).

As to claim 7, ePave discloses the patent application is filed at the patent office electronically (pages 28-29).

As to claim 8, ePave discloses executing the patent application with a digital signature of an inventor, assignee, or registered patent practitioner before the patent application is filed (pages 19-20, 28-29).

As to claim 11, ePave discloses transmitting notification that the patent application was filed to an intellectual property server (pages 24-31).

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of Hsu et al., U. S. Patent 5,982,898.

As to claims 9-10, ePave discloses encrypting the patent application before submitting the patent office (page 33); maintaining a registry of public keys at the patent office (page 5); decrypting of the patent application by the patent office is inherent for

the system of ePave because the patent office has to decrypt the patent application in order to read. EPave does not specifically teach encrypting the patent application with a private key of the inventor, assignee, or registered patent practitioner, and decrypting the patent application with a public key for the inventor, assignee, or registered patent practitioner. However, Hsu teaches using private key and public key to encrypt or decrypt information (abstract and Figs1-2). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the feature of using private key and public key to encrypt or decrypt the patent application for preventing unauthorized access.

7. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of Whitmyer, Jr., U. S. Patent 6,182,078.

As to claims 12-14, ePave discloses a computer-implement method for securing intellectual property rights as discussed above. EPave does not specifically disclose automatic calendaring by the IP server of a deadline data for foreign filing under an international convention, transmitting a reminder communication from the IP server to a specified address at a specified time period before the deadline date, and automatic converting the provisional patent application to a non-provisional patent application. However, Whitmyer teach automatically generating a reminder regarding important events and transmitting the reminder to correspondent clients (column 3 lines 38-65 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of generating a reminder regarding



important events, such as priority filing deadlines and transmitting the reminder to correspondent patent applicants because it would remind the patent applicants to submit proper documents before these deadlines.

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of U. S. Patent Application Specification Authoring Guide for WordPerfect XML Template, published by U. S. Patent and Trademark Office on December 14, 1999.

As to claims 15-17, ePave discloses a method for electronically filing patent applications. EPave does not specifically disclose submitting drawings along with the electronic patent application. However, U. S. Patent Application Specification Authoring Guide for WordPerfect XML Template discloses this matter (page 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of submitting drawings along with the electronic patent application so that the applicant can submit all the necessary information in one single transmission, this easy task would attract more applicants filing patent applications electronically.

#### **(10) Response to Argument**

The appellant argues ePave teaches put a pre-existing patent application in a proper format for electronic filing, but fails to teach generate a patent application automatically from a filled-out invention disclosure form (see page 7 of the appeal brief). First, examiner believes that the claim language does not indicate the user filed

information is a pre-existing patent application or is a new application. Secondly, ePave teaches a user electronically files a patent application live by filling out the invention disclosure information (page 18), and then a patent application serial number is assigned by the server at time of the package submission (page 51), that correspond to the content of generate a patent application automatically from a filled-out invention disclosure form.

The appellant argues that ePave fails to teach "an electronic invention disclosure form to be filled out" or a form to disclose an invention (see page 8 of the appeal brief), examiner respectfully disagrees because ePave teaches an electronic form allows a user to fill out not only the biographical information of the patent application but also the title of the invention (page 18 Figure 7-4), and the title of the invention is considered a part of invention disclosure.

The appellant argues that ePave fails to teach the form is provided from a server computer to a client computer and that a filled-out disclosure is received by the same server (see page 9 of the appeal brief). Examiner believes that ePave teaches this limitation because ePave software that provides the form to the client computer can be downloaded from the USPTO server (see page 12 install the downloaded ePave from the PTO web), and then the client submits the filled out disclosure form back to USPTO server (page 29). The appellant contends ePave does not teach the same server provides the form and receives the filled out form (see page 10 of the appeal brief), examiner respectfully disagrees. A "server" can be a single-architecture computer device, or can be a multiple-architecture computer device which refers as in "server

cluster" environment. The phrase "server cluster" means as a group of independent computers that work together as a single system (i.e. defined by Microsoft Press Computer Dictionary). A server cluster presents the appearance of a single server to a client". Since the USPTO server in ePAVE appears to the client computer or the user as a single server, and the appellant has not given a clearly definition in neither the specification nor the claims regarding the word "server", examiner believes that she has reasonably interpreted the limitation. Thus, ePave teaches the same server provides the form and receives the filled out form.

The appellant argues that ePave fails to teach a "filled out invention disclosure in an electronic form" and "automatically converting the invention disclosure form into a format of a patent application" (see pages 11-12 of the appeal brief). As discussed in the second paragraph of this section above, EPave teaches a "filled out invention disclosure in an electronic form" as an example shown in page 18 Figure 7-4. Furthermore, the purpose of the ePave User Guide is to allow the applicants to file and submit patent applications electronically (see the INTRODUCTION section of page 1), and ePave teaches electronically submit the filled out forms to USPTO (pages 28-29); thus, ePave teaches "automatically converting the invention disclosure form into a format of a patent application".

The appellant further argues that ePave fails to teach "automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server" (see pages 12-13 of the appeal brief). Examiner believes that the "Send to USPTO" button

corresponds to the single click instruction by the user (see ePave page 29), and as discussed in the proceeding paragraph the purpose of ePave User Guide is to allow the applicants to file and submit patent applications electronically and ePave teaches electronically submit the filled out forms to USPTO; thus, ePave teaches "automatically converting the invention disclosure form into a format of a patent application" in response to the click for filing.

The appellant argues that ePave fails to teach "actively promoting of an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention" as recited in claim 2, and "active promoting of an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention" as recited claim 3 (see page 14 of the appeal brief). Examiner respectfully disagrees, because ePave teaches provides pop-up windows to the user for promoting the user enter detailed information regarding the invention, such as entering the title of the invention, inventor information (see pages 18-20, 51-52), that corresponds to the limitations in claims 2 and 3.

Furthermore, the appellant argues that ePave fails to teach "wherein information in pre-selected fields of the invention disclosure form is selectively placed in a pre-selected location in said patent application" (see page 15 of the appeal brief), examiner believes that ePaves teaches this limitation, in particular on page 18 Figures 7-3 and Figure 7-4 show that there are drop down lists that allow user to select information from the lists to be placed in the patent application. For example, the drop down list for "Prerequisites" (see Figure 7-3 of page 18) and "Title" (see Figure 7-4 of page 18).

In response to the appellant's arguments that ePave and XML Guide fails to teach claims 15-17, examiner believes that as discussed in the office action ePave discloses a method for electronic filing patent applications, but fails to explicitly teach submitting drawings/figures along with the electronic patent application, and XML Guide teaches this deficiency. XML teaches how to attach the drawings/figures to the patent application, that comprising the ability of scanning, inserting, moving and removing the drawings/figures (see page 26 of XML Guide), which satisfies the limitations of facilitate creation of figures as presented in claims 15-17.

All other arguments are based on the arguments discussed above; thus, they are reversed on the same basis.

For the above reasons, it is believed that the rejections should be sustained.

**(11) Related Proceeding(s) Appendix**

The decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer as following:

- the Board has affirmed the examiner's rejection for U.S. Patent Application No. 09/996,338 (Appeal No. 2007-0776)

Respectfully submitted,

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